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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,826	08/23/2006	Mike S.D. Juang	7207-68336-04	1146
24197 7590 09/21/2009 KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204				
EXAMINER KILMAN, LESZEK B				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/21/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/590,826

Applicant(s)

JUANG, MIKE S.D.

Examiner

Ieszek b. kiliman

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14, 17, 18, 22, 25-27, 30, 32, 34 and 36-48 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) ____ is/are allowed.

- 6) ☒ Claim(s) 1-11, 14, 17, 18, 22, 25-27, 30, 32, 34, 36-48 is/are rejected.

- 7) ☐ Claim(s) ____ is/are objected to.

- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: ____.

The finality of the previous office action is hereby withdrawn in view of the new grounds of rejections

DETAILED ACTION

Claim Rejections - 35 USC § 102

1, The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11,14,17,18,22,25-27,30,32,34,36-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mackiewicz'361.

The applied Mackiewicz'361 reference teaches that it is well known in the art to make and use coated paper products comprising a paper substrate and starch containing coating. The applied reference teaches that article may contain multiple coatings. Base sheet paper used by applicants is available on the market. Method used by applicants to produce the paper product is a standard method used in industry. The prior art coating composition contains all elements used by applicants. Gurley density disclosed in the prior art clearly overlaps with the claimed density.

In addition, the prior art teaches how to optimize density and smoothness of coatings.

It is evident from the prior art disclosure that articles of the prior art are the same as the claimed paper articles. The examiner submits that the properties of the prior art articles would have been the same as the properties claimed in the applicants invention.

See Mackiewicz'361 column 2, lines 35-47, column 3, lines 30-55, column 5 bottom through column 6, lines 1-35, column 9, lines 9-16 and Table 3.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-11,14,17,18,22,25-27,30,32,34,36-48 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Billmers'270.

The applied Billmers'270 reference teaches that it is well known in the art to make and use coated paper products comprising a paper substrate and starch containing coating. The applied reference teaches that article may contain multiple coatings. Base sheet paper used by applicants is available on the market. Method used by applicants to produce the paper product is a standard method used in industry. The prior art coating composition contains all elements used by applicants. Gurley density disclosed in the prior art clearly overlaps with the claimed density.

In addition, the prior art teaches how to optimize density and smoothness of coatings.

It is evident from the prior art disclosure that articles of the prior art are the same as the claimed paper articles. The examiner submits that the properties of the prior art articles would have been the same as the properties claimed in the applicants invention.

See abstract, column 2, lines 8-67, column 4, lines 57-67, column 5, lines 13-55, column 6, lines 21-35, Table 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ieszek B. Kilian whose telephone number is 571-272-1509. The examiner can normally be reached on M-T, 6.30-5.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, callie shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lk
/leszek b kiliman/
Primary Examiner, Art Unit 1794